Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN C. TRASK

Appeal No. 2004-1408
Application No. 10/166,590

ON BRIEF

Before PAK, OWENS, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON REHEARING

This is in response to the appellant's request for rehearing (request) pursuant to 37 CFR § 1.197(b) (2003)(effective Dec. 1, 1997), filed on Jul. 15, 2004 (paper 15), of our Jun. 28, 2004 decision (paper 14). In our original decision, we affirmed the examiner's rejection under 35 U.S.C. § 103(a) (2003) of appealed claims 27 and 30 as unpatentable over U.S. Patent No. 4,150,851 issued to Cienfuegos on Apr. 24, 1979. (Original decision, pages 3-9.)

Because we do not find any of the appellant's arguments to be persuasive, we decline to modify our original decision in any respect.

The appellant argues that Cienfuegos does not provide any motivation to form the claimed adjustable support and in fact teaches away from it. (Request at 2.) Specifically, the appellant alleges (id.):

> The structural requirements logically imposed by the reference to form a device adjustable to hold a seat at a plurality of closely spaced apart elevations to accommodate a plurality of users having different sizes is in direct conflict with the required large distance ("greater than about 2 inches") between first and second *adjacent* holdable positions. The reference teaches away from the claimed widely spaced apart holdable positions by suggesting a mechanism operable to hold a seat at a plurality of closely spaced apart positions to fit all of a plurality of users having a variety of sizes. In conflict with MPEP 2143.01, the asserted modification renders the prior art unsatisfactory for its intended purpose.

We do not agree. While Cienfuegos teaches that an "exercycle in a gymnasium is used by large numbers of different people during the course of the day" (column 3, lines 1-3), nothing in the reference indicates that the disclosed adjustable support must necessarily accommodate "all of a plurality of users having a variety of sizes." That is, nothing in Cienfuegos indicates to one of ordinary skill in the art that a

support that is incrementally adjustable in height by greater than about 2 inches would be unusable. In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

To the contrary, Cienfuegos would have suggested to one of ordinary skill in the art that a support having several adjustable height positions at, e.g., about 2-inch increments would be suitable for use as part of a home exercycle or bicycle. Although the same adjustable support might not comfortably accommodate the entire world population, it would nevertheless be useful for a significant portion of the general population. In the case of a child's bicycle, such increments would facilitate periodic height adjustments commensurate with the natural growth of the child. Here, one of ordinary skill in the art would have recognized from the teachings of the prior art that the number of possible height positions and the distance between the positions of adjacent heights would necessarily affect the cost of manufacturing the device. For a given overall length of adjustable support, the total number of drilled holes increases as the distance between the adjacent height positions is decreased. Thus, one of ordinary skill in the art would have balanced the desirability of accommodating

the entire population against the cost of manufacturing the device.

The appellant urges that if the first and second holdable positions were spaced at greater than 2 inches in the support of Cienfuegos, a person with an intermediate height "unavoidably would be precluded from supporting the seat at his desired ergonomic elevation..." (Request at 3.) We are not persuaded, because the appellant has failed to identify any objective evidence in the record establishing that a person of such intermediate height would be inconvenienced to any significant degree, much less unable to use the exercycle or bicycle.

The appellant alleges that the recited distance between the first and second holdable positions "is outside a known, or even reasonably suggested, range." (Request at 3.) Again, however, the appellant has utterly failed to establish that the recited distance would result in a support that is unusable for any of the purposes disclosed or suggested in Cienfuegos.

The appellant contends that "more precise adjustment obtained from a smaller spacing was admitted by the Examiner at page 2 of paper No. 5, which constitutes evidence in the record to substantiate criticality for a size of a spacing between holdable positions." (Request at 4.) This position lacks

merit. In the final Office action mailed May 1, 2003 (paper 5), the examiner merely repeated a finding of fact made in the Office action mailed Feb. 4, 2003 (paper 3). This finding of fact, which the appellant does not dispute, does not constitute evidence substantiating "criticality," much less unexpected criticality. Rather, it constitutes evidence of obviousness.

The appellant's request is granted to the extent of reconsidering our original decision but is denied with respect to making any substantive changes thereto.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

Chung K. Pak Administrative Patent Judge	)	
Terry J. Owens Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Romulo H. Delmendo Administrative Patent Judge	)	

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